NOMURA et al.
Appl. No. 09/892,747
Response to Office Action dated May 18, 2005

REMARKS

Reconsideration and allowance of the subject patent application are respectfully requested.

Applicants again respectfully request that receipt of the certified copies of the two (2) priority documents be acknowledged. These documents were submitted on June 28, 2001 as evidenced by the copy of the postcard receipt attached to the prior response.

Claims 1-7, 12-21, 26 and 27 were rejected under 35 U.S.C. Section 102(b) as allegedly being "anticipated" by Oki et al. (U.S. Patent No. 5,859,969). While not acquiescing in this rejection, claims 1, 12 and 21 have been amended. As such, the discussion below makes reference to amended claims 1, 12 and 21.

Claims 1, 12 and 21 variously recite a program supply method and system in which a program supplied from a server is executed on a user system to thereby confirm proper operation of the program and, after confirming operation by executing the program on the user system, payment for the program is requested. Oki et al. discloses a remote installation system and method for enabling a user of a terminal to obtain software through a communication line. However, Oki et al. contains no disclosure regarding payment for the obtained software and thus fails to disclose, among other things, requesting payment for a program after executing the program to confirm its operation. Because Oki et al. fails to disclose this feature as specified in claims 1, 12 and 21, Oki *et al.* cannot anticipate these claims. *See, e.g., Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.")

Claims 2-7 and 26 depend from claim 1 and claims 13-20 depend from claim 12. These claims are believed to be allowable because of this dependency and because of the additional patentable features recited therein.

Although not identified in the statement of the rejection on page 4 of the 5/18/05 Office Action, claims 23 and 24 are also apparently rejected as allegedly being "anticipated" by Oki et al. *See* 5/18/05 Office Action, pages 9-10. Each of claims 23 and 24 has been amended to describe transmitting a notification of operation confirmation to a server after a program is

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executed to allow the server to confirm the proper operation state of the program. Oki et al. does not disclose or suggest this feature therefore does not anticipate these claims. The 5/18/05 Office Action references Figure 5 of Oki et al. in connection with "confirming of decompression, moving/re-naming files and registration" as allegedly signifying operation of the program. *See* 5/18/05 Office Action, pages 9-10. Applicants do not agree or concede that these decompressing, moving, etc. operations constitute a disclosure of executing a program to confirm its proper operation. In any event, these operations do not constitute (or even suggest) sending a notification to a server after a program is executed on the user system to allow the server to confirm the proper operation state of the program. For at least these reasons, Applicants respectfully submit that Oki et al. does not anticipate claims 23 and 24.

Claim 27 depends from claim 23 and believed to be allowable because of this dependency.

Claim 21 was rejected under 35 U.S.C. Section 102(b) as allegedly being anticipated by Platt (U.S. Patent No. 5,421,009). While not acquiescing in this rejection, claim 21 has been amended to describe executing a program supplied from a server to confirm its proper operation and, upon confirmation of the proper operation, the server requesting the user system for payment for the program.

Platt discloses a method of remotely installing software from a central location. Before attempting to install the software, Platt ensures that the remote system can be reached through the network, that the remote system has the capability of running processes remotely, that the remote system has all the commands necessary to perform the installation, that the remote system has the correct hardware and software to support the installation and that sufficient disk space exists on the remote computer system for the installation. Platt then combines all files that are being remotely installed into a single data stream, sends this single data stream over the network to the remote computer system, and separates the data stream into the original files on the remote system. There is no disclosure in Platt of, for example, requesting payment for a program, much less of requesting such payment after the program is executed on a user system to confirm its proper operation as specified in claim 21. Consequently, Platt does not anticipate claim 21.

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Claims 8-11, 22 and 25 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Oki et al. in view of Alexander et al. (U.S. Patent No. 6,134,593). While not acquiescing in this rejection, claims 8, 22 and 25 have been amended. As such, the discussion below makes reference to amended claims 8, 22 and 25.

In connection with independent claims 8 and 22, Oki admittedly fails to disclose asking a user to pay for a program after confirming operation of the program. *See* 5/18/05 Office Action, page 12. To remedy this acknowledged deficiency, the office action references Alexander et al., which discloses a method for a user to order, unlock and pay for a software application using a password to gain access to the software. The office action contends that paying for a program after confirming that the program is operable in a user system is well-known as evidenced by Alexander. *See* 5/18/05 Office Action, page 12. In support of this contention, the office action refers to Alexander's disclosure of paying for the software at step 345 "after installing said software at 305."

However, Alexander et al. does not describe requesting payment for a program <u>after</u> executing the program on a client computer as specified in claims 8 and 22. Indeed, Alexander et al. describes the opposite: requesting payment <u>before</u> executing the program. *See*, e.g., Abstract ("<u>After payment processing</u>, the server then transmits a password to the client based on the identifiers. <u>Thereafter</u>, the user enters the password <u>to gain access to and execute the vendor software application to which access was previously denied</u>.")(emphasis supplied); and col. 4, lines 65-67 (If, however, the module 210b is locked, it <u>cannot be executed without first processing payment</u> for the module and providing a password for the module.")(emphasis supplied).

Because neither Oki et al. nor Alexander et al. describes requesting payment for a program <u>after</u> executing the program on a client computer as specified in claims 8 and 22, the proposed combination of these documents would likewise have been deficient in this regard. Consequently, claims 8 and 22 would not have been made obvious by the combination of Oki et al. and Alexander et al.

Claims 9-11 depend from claim 8 and are believed to be allowable because of this dependency and because of the additional patentable features contained therein.

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Claim 25 calls for transmitting a notification of operation confirmation to a server after a program is executed to allow the server to confirm the proper operation state of the program. Neither Oki nor Alexander et al. discloses this feature and claim 25 is believed to distinguish over the proposed Oki-Alexander et al. combination for at least this reason.

Claims 28-30 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Oki in view of Thomas (U.S. Patent No. 4,446,519). In addition to these claims being allowable because Thomas fails to remedy the deficiencies of Oki with respect to claims 1, 12 and 21, from which claim 28-30 depend, respectively, Thomas further fails to disclose or suggest sending a notification to a server as specified in these claims.

Thomas discloses that security for computer software may be achieved by providing each purchaser of a software package with an electronic security device, which must be operatively connected to the purchaser's computer. The software sends coded interrogation signals to the electronic security device, which processes the interrogation signals and transmits coded response signals to the software. The program will not be executed unless the software recognizes the response signals according to pre-selected security criteria.

However, Thomas contains no disclosure of downloading a program from a server, much less sending confirmation to such a server confirming operation of a program downloaded therefrom. Instead Thomas discloses a plug-in circuit board element ("ESD") that is provided to legitimate purchasers of a software program. When the program is loaded into the working memory (RAM or ROM) of the computer and the program sequence is commenced, the software generates coded interrogation signals that are transmitted to the ESD. If the ESD is the correct one, which has been furnished to the purchaser along with the program, the ESD will recognize the interrogation signals and transmit proper coded response signals to the working memory of the computer. If and only if the software in the working memory receives the proper response signal from the ESD, the software will then generate command signals to the computer, which cause execution of the program. If the proper response signals are not received by the working memory containing the software program, the command signals are not generated and the computer cannot execute the program. Thus, Thomas is concerned with determining whether a program may be executed, not confirming operation of a program by executing it and then sending a signal to a server regarding the confirming. Consequently, Applicants respectfully

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submit that there is no disclosure or suggestion in Thomas of sending confirmation of proper operation of a program to a server from which a program has been downloaded.

Claims 31 and 32 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Fawcett (U.S. Patent No. 6,073,214) in view of Merkle et al. (U.S. Patent No. 6,330,549). Claim 31 is directed to a method performed by a user system to obtain a program from a server. The method comprises sending to the server operating environment data of the user system; receiving from the server a list of programs that is generated based on the operating environment data; sending to the server a request for one of the programs selected from the list; receiving the selected program from the server; installing the received program; executing the installed program to confirm its operation; and sending to the server a notification regarding the confirmation of operation.

Fawcett discloses a system and method for updating software on a user's computer in which, after a user computer establishes two-way communications with the update service computer, an inventory of computer software on the user computer is completed without interaction from the user, sent to the update service computer, and compared to database entries on the update service computer. The database entries from the database connected to the update service computer contain information about computer software that is available to a user. After the comparison, the user computer is sent back a summary of available computer software, which is displayed for the user. The summary contains information such as the availability of patches and fixes for existing computer software, new versions of existing computer software, and brand new computer software, new help files, etc. The user is then able to make one or more choices from the summary of available computer software, and have the computer software transferred from the update service computer to the user computer. The user may choose to update on the fly, or store update information for future update needs.

Fawcett does not disclose, among other things, executing an installed program to confirm its operation and then sending to a server a notification regarding the confirmation of operation. To remedy this deficiency, the Examiner relies on Merkle et al. Merkle et al. describes that the functionality of "protected shareware" may be controlled by a digitally signed messaging protocol. Protective code within the shareware controls the functionality of the shareware in response to authorization messages that are supplied directly or indirectly by the shareware

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supplier. These messages are digitally signed in whole or part by or on behalf of the shareware supplier using the supplier's secret signing key. The shareware, in turn, includes the public checking key for this digital signature of the supplier, thereby enabling the protective code to authenticate any such authorization message before acting in reliance upon it. The shareware includes an integrity self-checking routine, which is run at appropriate times to ensure that shareware, including its protective code, is in an anticipated state. Merkle et al. discloses communicating usage information to a billing computer, but contains no disclosure or suggestion of sending a notification regarding the confirmation of program operation to a server from which the program was downloaded. In other words, while Merkle et al. might suggest providing a billing computer to monitor usage, Merkle et al. does not (absent improper hindsight) suggest confirming operation of a program or sending a confirmation of this operation to the server that provided the program. Consequently, the proposed combination of Fawcett and Merkle et al. would not have made claim 31 and its dependent claim 32 obvious.
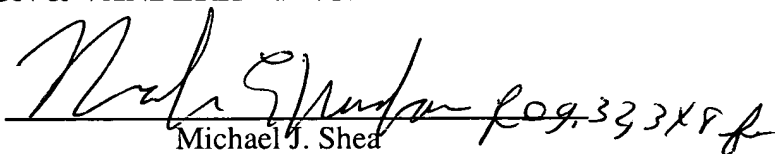
The above amendments are believed to place this application in condition for allowance. As such, entry is believed to be appropriate and is respectfully requested.

The pending claims are believed to be allowable and favorable office action is respectfully requested.

Respectfully submitted,

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